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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/046,500      | 10/24/2001  | Guy Richards         | 24180-124005        | 3373             |

7590 05/13/2004

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EXAMINER

NOLAN, SANDRA M

ART UNIT PAPER NUMBER

1772

DATE MAILED: 05/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/046,500

Applicant(s)

RICHARDS ET AL.

Examiner

Sandra M. Nolan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 November 2003 and 03 March 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 1-24 and 42-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>22 January 2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claims***

1. Claims 1-50 are pending. This action deals with claims 25-41.
2. Claims 1-24 and 42-50 have been withdrawn.

### ***Communications Received after the 13 August 2003 Office Action***

3. The office acknowledges receipt of:
  - the "Amendment under 37 CFR 1.111" dated 13 November 2003
  - the "37 CFR 1.132 Declaration of Dr. Robert Knoll" (the Knoll Declaration) dated 13 November 2003 (referring to docket number 24180-124-004 and identifying SN. 09/901,427, filed July 9, 2001 by Curie et al)
  - the information disclosure statement dated 22 January 2004
  - the "Response" dated 03 March 2004, sent in response to the office action dated 09 February 2004.

### ***Information Disclosure Statement***

4. The information disclosure statement (IDS) submitted on 22 January 2004 was considered by the examiner. The examiner has corrected the "Applicants" entry thereon to indicate Richards et al are the inventors.

### ***Rejections Maintained***

5. The 35 USC 102 rejection of claims 25-28 and 30-41, as anticipated by Schmidt et al (US 5,804,016), as recited in section 7 of the 13 August 2003 office action, is maintained for reasons of record.

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6. The 35 USC 103 rejection of claim 29 as unpatentable over Schmidt in view of Krishnakumar et al (US 5,303,834), as recited in section 10 of the 13 August 2003 office action, is maintained for reasons of record.

***Rejection Withdrawn***

7. The 35 USC 112 rejection of claim 29 for indefiniteness, as set out in section 5 of the 13 August 2003 office action, is withdrawn in view of applicants' amendment to claim 29, as indicated on page 4 of the 13 November 2003 amendment.

***Response to Comment re: The Information Disclosure Statement of 19 June 2002***

8. On page 7 of the 13 November 2003 amendment, applicants discuss the information disclosure statement (IDS) dated 19 June 2002, which was stamped as received in Tech. Center R3700.

9. Since this application has now been recorded in the Office's eDAN/IFW database, all documents properly scanned relating to it are available to the undersigned, who is in Technology Center 1700.

10. That IDS was reviewed the undersigned. She has initialed the citations considered and dated it. See sheet 11 of 11.

11. The examiner acknowledges that she crossed off the following citations: IA, ID, IM, IP, IQ, IR, IS and IZ all of which were "Other Documents" on pages 8-11 of the IDS.

12. The information disclosure statement filed on 17 July 2002 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because all of the citations do not comply with MPEP 606 A(1). It has been placed in the application file, but all of the information referred to therein has not been considered as to the merits.

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13. Applicants are advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609, ¶A(1) and ¶C(1).

15. MPEP 609 A(1) states, in pertinent part:

“Each publication must be identified by publisher, author (if any), title, relevant pages of the publication, and date and place of publication.”

16. MPEP 609 C(1) deals with the handling of noncomplying IDS's.

### ***Response to Arguments***

17. Applicant's arguments filed in the amendment of 13 November 2003 (I) and the response of 03 March 2004 (II) have been fully considered but they are not persuasive.

#### **I. The 13 November 2003 Amendment**

In the 13 November 2003 response, applicants presented various arguments, including some relating to the Knoll Declaration, which declaration will be discussed separately here.

##### **a. The Knoll Declaration**

The declaration filed on 13 November 2003 in this application is of no probative value because it appears to have been prepared for US SN. 09/907,427 and not for this case. See page 1 of the Knoll Declaration.

This examiner notes that, in section 4 of the declaration Dr. Knoll (declarant), refers to "the August 13, 2003 office action in the above-identified application". In light of declarant's apparent confusion regarding the application about which he was making statements, it is deemed appropriate not to consider the declaration's content.

b. Applicants' Arguments in the 13 November 2003 Amendment

The arguments submitted on pages 7 through 23 of the 13 November 2003 amendment will be discussed in the order in which they were presented there.

On page 7, applicants argue that the 35 USC 112 rejection of claim 29 should be withdrawn in light of their amendment thereto.

The examiner agrees and has withdrawn that rejection.

On pages 8-9, applicants argue that the term "finish", as discussed in the specification and recited in base claims 25, 33 and 38, refers to the portion of the container/perform that extends from the support flange to its opening to form its mouth.

The examiner accepts applicants' explanation of the term's interpretation. Also, she notes that the claims now before are directed to preforms, not to containers.

On pages 9-10, applicants discuss the terms "internal" and "intermediate" and state that the difference between the terms is not significant when discussing the 13 August 2003 office action.

The examiner acknowledges that the term "intermediate" does not appear in the instant claims. Accordingly, upon reconsideration, she agrees with applicants that, for now, the difference in the terms' meanings is not significant.

On page 10, applicants argue that Schmidt is concerned with polyethylene terephthalate (PET) multilayer containers.

However, Schmidt states, at col. 10, lines 32-47, that the invention as described in the patent, can be modified (see col. 10, lines 33-34) and that "[p]olyesters based on terephthalic or isophthalic acid are commercially available and convenient" (see col. 10, lines 45-47).

Most importantly, Schmidt states that "one or more layers of the preform and container. . . can be made of various other polymers, such as polyolefins (e.g., polypropylene and polyethylene). . ." (see col. 10, lines 36-39). [Emphasis added.]

On page 11, applicants argue that "Schmidt haphazardly suggests" that materials other than PET (polyethylene terephthalate) and PC-PET (polycarbonate-polyethylene terephthalate) can be use in the patented invention; and that its makes a "catch-all inclusion of PP (polypropylene)".

However, the examiner disagrees. The so-called "haphazard suggestion" goes into significant detail in describing materials other than PET and PC-PET that can be used to make the performs and containers of the patented invention. In column 10, lines 36 through 44 deal with a large Schmidt's 8- to 9-line description to be either "haphazard" or "catch-all".

On pages 12-17, applicants state, and discuss at length, their position that the Schmidt invention lies in its injection method rather than in its perform construction.

However, the examiner has considered the Schmidt teachings in their entirety and concludes that it is an appropriate reference under 35 USC 102.

Also, the references to the Knoll Declaration are not persuasive because its content has not been considered for reasons given above.

On page 18, applicants argue that the suggested alternatives to PET in Schmidt's teachings are "just that".

The examiner agrees. One of the alternatives to PET in the Schmidt invention is polypropylene. Therefore, Schmidt teaches the use of polypropylene in its invention and a 35 USC 102 rejection is appropriate.

On page 19, applicants argue that the teachings of Schmidt must be viewed as a whole and that focusing only on PP (polypropylene) distorts its true teachings.

Once again, the examiner agrees. The Schmidt patent describes PET in great detail and teaches, in col. 10, that other polymers may be used alternatively. Note that applicants have asserted, in several places in the second full paragraph on page 18 of the 13 November 2003 response, that PP is an alternative to PET.

On pages 20-21, applicants discuss intrinsic viscosity at length and argue that Schmidt says that "intrinsic viscosity (I.V.) effects [sic] the processability of the resins" [quoted from col. 11, about lines 45-47 of the patent].

The examiner agrees that intrinsic viscosity affects the processability of resins. However, it is unclear to the examiner how this statement renders Schmidt an inappropriate section 102 reference.

There is nothing in Schmidt or the record of this application to support the proposition, as stated on page 21 of the response, that changing the polymer used in



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Schmidt's perform will necessarily result in a change in how it performs during subsequent shaping operations.

Once again, applicants' discussion regarding the Knoll Declaration are not persuasive for reasons presented earlier.

In the paragraph bridging pages 21 and 22, applicants argue that Schmidt must teach each and every element of the claims in order to place the skilled artisan in possession of the invention.

The examiner maintains that Schmidt teaches each and every claimed element.

Lastly, applicants posit that it would not have been obvious to combine Schmidt's teaching of PET with its disclosure of PP under 35 USC 103.

However, no such rejection has been made.

## II. The 03 March 2004 Response

The arguments presented in the 03 March 2004 response, submitted after the office action mailed on 09 February 2004, have been considered.

The examiner is satisfied that applicants did not deem it appropriate to comment on the teachings of Krishnakumar (US 5,303,834) in detail because of the arguments they had made concerning Schmidt in their 13 November 2003 response.

Accordingly, the comments concerning Schmidt, as they relate to the 35 USC 102 rejection, are deemed equally applicable to the 35 USC 103 rejection based on Schmidt in combination with Krishnakumar.

The examiner will make no comment concerning Krishnakumar here.

***Final Rejection***

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

19. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

Any inquiry concerning this communication should be directed to Sandra M. Nolan, whose telephone number is 571/272-1495. She can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time. If attempts to reach the examiner are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498.

The fax number for patent application documents is 703/872-9306.



S. M. Nolan  
Primary Examiner  
Technology Center 1700